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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,313	10/24/2001	Stephen Chin	0203375-002910US	3142
20350	7590	10/20/2005		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER DASS, HARISH T	
			ART UNIT 3628	PAPER NUMBER

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,313

Applicant(s)

CHIN, STEPHEN

Examiner

Harish T. Dass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/1/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings et al (Hereinafter Jennings, US Pat. 5,825,003) in view of Datek.com (hereinafter Datek).

Re. Claim 11, Jennings discloses providing a computational system interfaced with Internet, the computational system including a computer processor (CPU), a database, and a server that contacts the computational system with the ATM network or the like [see entire document particularly, abstract; Figure 15; C2 L36-56; C3 L50 to C4 L13; C7 L46-L59 (see home banking, source baking system, host system, and use of personal computer (PC), which is mostly found in context of online banking where user has an established account in a financial institution and manages his/her account using Internet

from his/her home or office by using PC connected to banking server by Internet communication));

establishing a stored value account of a user, the stored value account identifying an electronic funds level previously credited to the account by the user and information defining the stored value account being stored within the database [C2 L36-L62; C4 L1-L65; C5 L37 to C6 L18; C9 L9-L16; C26 L52 to C27 L62; -- see deposited, valid account number. It is mostly known that a user account (saving, checking, etc) is established by depositing money and the account has user's information (record) which is stored in financial institution's computer system database];

receiving a request from the user over Internet (on-line) at a server (host system) to transfer at least some of the funds in the stored value account to a recipient, the request being received in response to and substantially contemporaneous (instantly) with consummation (settlement) of a transaction between the sender and recipient [abstract; C1 L45 to C2 L62; C3 L50 to C4 L13; C5 L42 to C5 L55 to C6 L40; C27 L48 to C28 L22], sending the requested funds to the recipient [C4 L1-L5; C13 L44 to C14 L40; C18 L20-L67], and debiting the stored value account [C5 L30-L40; C8 L3-L43; C27 L48 to C28 L20]. Jennings discloses electronic fund transfer over the ATM network or the like. Jennings does not explicitly disclose transfer over the Internet. However, Datek discloses an on-line trading system over the Internet [See selected Web pages from Datek: 1-3, 6, 9, 11-13, 15, and 17] to transfer money and trade securities using Internet for a faster way to trade and transfer money. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure

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of Jennings and Datek, to facilitate on-line transfer of money using Internet to speed up the process, which eventually saves the cost to the user.

Re. Claims 13-14, Jennings further discloses confirmation message is displayed to the customer [C9 L17-L32; C11 L10 to C12 L50; C14 L29-L45]. Jennings does not explicitly disclose email. However, Schrader discloses email messages [C19 L25-L45] to allow the user to receive email message from financial institution or send message to financial institutions. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Jennings and add email to allow the user to get message for inquiries about specific transactions.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings and Datek as applied to claim 11 above, and further in view of Nethery (US 6,070,798).

Re. Claim 12, neither Jennings nor Datek discloses generating a money order in the name of the recipient, and wherein the requested funds are sent by sending the money order. However, Nethery discloses this step [Abstract; Figure 5; C1 L5 to C2 L38] to enable remote purchase over a network. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Jennings and Datek to add money negotiable instrument such as money order to be send through electronic communication link.

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Claim 15 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings in view of Schrader et al (hereinafter Schrader – 5,903,881).

Re. Claim 15, Jennings further discloses Providing a computational system interfaced with Internet, the computational system including a computer processor, a database, and a server that contacts the computational system with the ATM network or the like [see entire document particularly, abstract; Figure 15; C2 L36-56; C3 L50 to C4 L13; C7 L46-L59 (see home banking, source baking system, host system, and use of personal computer (PC), which is mostly found in context of online banking where user has an established account in a financial institution and manages his/her account using Internet from his/her home or office by using PC connected to banking server by Internet communication)];

establishing a stored value account of a user, the stored value account identifying an electronic funds level previously credited to the account by the user and information defining the stored value account being stored within the database [C2 L36-L62; C4 L1-L65; C5 L37 to C6 L18; C9 L9-L16; C26 L52 to C27 L62; -- see deposited, valid account number. It is mostly known that a user account (saving, checking, etc) is established by depositing money and the account has user's information (record) which is stored in financial institution's computer system database];

receiving a request from the user at the server to increase the electronic funds level of the stored value account wherein the request includes information on a payment instrument to be used to increase the electronic funds level [C2 L60-L62; C3 L50-L67;

C4 L4-17; C5 L37-L38; C5 L42 to C6 L40; C27 L48 to C28 L22], from the server, sending an authorization request to charge the payment instrument [Abstract; Figures 12-14; C1 L45 to C2 L62; C26 L52 to C27 L20; C17 L45-L67], receiving at the server an authorization to charge the payment instrument [Abstract; Figures 12-14; C1 L45 to C2 L62; C26 L52 to C27 L20; C5 L9-L30; C17 L45-L67], and providing the requested funds to the recipient [C5 L42 to C6 L8; C9 L17 to C10 L50; C28 L1-L22];

increase the electronic funds level of the stored value account in accordance with the authorization [C2 LC60-L62; C4 L5-L6; -- see deposited];

receiving request from the user to transfer at least some of the funds in the stored value account to a recipient [C5 L37-L38;];

Jennings does not explicitly disclose server computer. However, Schrader further discloses server computer [Figure 13; C12 L28 to C13 L7; C15 L5-L27] to allow the Internet based communication. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Jennings and include computer server, as taught by Schrader, to allow the client computer download a configuration file which contains the financial institutions description information.

Re. Claims 17-18, Jennings further discloses confirmation message is displayed to the customer [C9 L17-L32; C11 L10 to C12 L50; C14 L29-L45]. Jennings does not explicitly disclose email. However, Schrader discloses email messages [C19 L25-L45] to allow the user to receive email message from financial institution or send message to financial

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institutions. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Jennings and add email to allow the user to get message for inquiries about specific transactions.

Re. Claims 19-21, Jennings further discloses wherein the recipient is a merchant (point of sale) [C8 L38], and wherein the payment instrument is a credit card [C9 L10-L12].

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings in view of Schrader as applied to claim 15 above, and further in view of Nethery (US 6,070,798).

Re. Claim 16, neither Jennings nor Schrader or Mori discloses generating a money order in the name of the recipient, and wherein the requested funds are sent by sending the money order. However, Nethery discloses this step [Abstract; Figure 5; C1 L5 to C2 L38] to enable remote purchase over a network. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Jennings and Schrader to add money negotiable instrument such as money order to be send through electronic communication link.

Response to Arguments

Response to Applicant's arguments filed on 9/1/2005.

In Response to Applicant's argument (page 7 of Remarks) the finality of previous office action is withdrawn. Examiner thanks the Applicant for point out this error.

In Response to Applicant's argument In Response to Applicant's argument (page 8 of Remarks and page 10) "Jennings is directed generally to a system that permits funds transfers to be executed over an automatic-teller machine ("ATM") network.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Jennings invention is transfer of money or fund over ATM network, which is a communication network similar to Internet communication and has no effect on transferring fund from sender to receiver. For example, figure 1, replacing the network switch 28 with Internet network has no effect on inputting fund formation by sender at terminal 22 and receiving fund at financial institution system 32 or recipient.

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Transferring of fund using Internet is disclosed by secondary reference (Datek).

In response to Applicant's argument (page 8, last paragraph) that "there is nothing in this portion of Jennings that teaches a transaction between the sender and recipient, consummation of which is substantially contemporaneous with the fund transfer". Applicant attention is directed to Col. 2 lines 16-35, where funds are transferred from customer (sender) into another account (recipient) in substantially in real time (without any necessary time lag for settlement) across international borders (different financial institutions).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., 2nd paragraph, page 6 of remark) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

HTD
10/14/05
1.


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